

REMARKS

Claims 1-20 are pending in this application as amended. The Examiner rejected claims 1-14. New claims 15-20 have been added. No new matter has been added. For the reasons below, Applicant traverses the Examiner's rejections and respectfully submits that the claims are in condition for allowance.

Claim Objection

The Examiner objected to claim 1 stating that the term "captively" is not a word. Applicant respectfully disagrees and submits that "captively" is an adverb form of the term "captive." As such, Applicant requests that the Examiner's objection be withdrawn.

Claim Rejections Under 35 U.S.C. 103(a)

The Examiner has rejected original claims 1-14 under 35 U.S.C. 103(a) as being unpatentable over Sparks (U.S. Patent No. 1,485,641) in view of Westfall (U.S. Patent No. 6,663,259). Applicant respectfully traverses the Examiner's rejections. Applicant does not agree with the characterization or combination of the references set forth by the Examiner. Neither does the Applicant agree with the rejection of original claims 1-14.

Applicant does agree with the Examiner's admission that "Sparks fails to disclose a hook coupled to the frame for suspending the frame from a separate structure (e.g., as a supporting structure)." [Office Action at page 4, lines 1-2]. Applicant disagrees, however, with the Examiner's statement that "[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the decorative lamp frame structure of D.R. Sparks with a hook of Westfall to provide an alternative mounting structure (e.g., other than floor standing) to place and/or hang the lamp frame to other structure (e.g. wall)." [Id. at lines 7-10].

The present rejections do not establish a *prima facie* case of obviousness under 35 U.S.C. §103(a). To establish a *prima facie* case of obviousness there must be some suggestion or motivation, either in the references or in the knowledge generally available among those of ordinary skill in the art, to modify the reference. M.P.E.P. §2143; see In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991). There is no motivation or suggestion in the references themselves, in the

present record, or in the knowledge generally available to one of ordinary skill in the art to modify the lamp of Sparks with the hook of Westfall.

The lamp of Sparks is a freestanding lamp, designed and configured to be supported by “a flat base 10 having a pillar or stand 11 in the form of legs supported centrally thereof on a tubular post 12, threaded into the base and extending upwardly through the leg shaped pillar 11.” [Sparks at lines 52-57; Figs. 1 & 2]. In contrast, the hooks 22 of Westfall are not for supporting a lamp, much less for combination with the freestanding lamp of Sparks. Instead, Westfall describes the hooks 22 as a means for releasably retaining a decorative element 20 from a support structure 12 of a decorative frame 10. [Westfall at Col. 3, lines 21-28, 41-48; Figs. 1 & 2]. For example, the hook 22 of Westfall “extend[s] from the rear surface 26 of the decorative element 20” for releasably retaining the decorative element 20 on the support structure 12. [Id.] Westfall then describes mounting the support structure 12 to a lighting fixture 28, “such as a bar-type lighting fixture typically found in bathrooms,” [Id. at Col. 1, lines 11-12], through “a compression fitting between the support structure and the lighting fixture 28.” [Id. at Col. 4, lines 4-8; Figs. 1 & 3]. Westfall teaches that the compression fitting, not the hook 22, is for mounting his support structure 12 and decorative frame 10 to the lighting fixture 28. [Id.]

Further, under the current record, there is no motivation or teaching of how Sparks could possibly be modified to function with Westfall’s hooks, or even if such a combination is possible. Such a combination, as asserted by the Examiner, would fundamentally alter and render superfluous the supporting structure taught by Sparks, and would replace that supporting structure with the hook of Westfall, which is not even designed to support the entire decorative frame disclosed in Westfall. Applicant maintains “there must be a teaching or suggestion within the prior art, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources of information, to select particular elements, and to combine them in the way they were combined by the inventor.” ATD v. Lydall Inc., 159 F.3d 534, 546 (Fed. Cir. 1998); see also In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998), In re Dance, 160 F.3d 1339, 1343 (Fed. Cir. 1998). Here, at the very least, given the inherent technical difficulties of fundamentally modifying the support structure of Sparks as asserted by the Examiner, one of ordinary skill would not attempt the asserted modification.

Similarly, the circular skirt of Sparks reaches away from the idea of mounting the lamp on a separate structure, as the circular design provides no stable surface on which to support the lamp.

The Examiner's asserted motivation does not address the above points and merely emphasizes the hindsight nature of the combination, alleging "the modification would have provided an additional benefit of supporting the frame to other separate structure." [Office Action, page 4, lines 11-12]. However, there is no indication that anything other than Sparks' "flat base 10 having a pillar or stand 11 in the form of legs" may be used to support his freestanding lamp. [Sparks at lines 52-55; Figs. 1 & 2]. Instead, the Examiner blindly asserts the combination and applies an advantage having no support in the record.

If the Examiner is relying on personal knowledge, Applicant hereby expressly requests the Examiner to provide an affidavit under 37 C.F.R. § 1.104(d)(2) supporting any of the asserted facts that are not taught by the prior art of record, or produce prior art as required by M.P.E.P. § 2144.03. Accordingly, Applicant hereby reserves the right to further contest the combinability of these references at a later date.

Applicant maintains that the combination of Spark's freestanding lamp Westfall's hook is legally improper. But even if there were such a motivation to combine, what would be accomplished is that the lamp of Sparks would have Westfall's hook that is part of "an attachment means 18 adapted to releasably retain a decorative element 20." [Westfall, Col. 3, lines 41-48; Figs. 1 & 2]. The lamp of Sparks would still be configured to be freestanding on "a flat base 10 having a pillar or stand 11 in the form of legs supported centrally thereof on a tubular post 12," [Sparks at lines 52-55; Figs. 1 & 2], and not modified "to provide an alternative mounting structure (e.g., other than floor standing) to place and/or hang the lamp frame to other structure (e.g. wall)" as asserted by the Examiner. [Office Action at page 4, lines 7-10].

In contrast to Sparks alone or in combination of Westfall, original claim 1 recites in part "a hook coupled to the frame for suspending the frame from a separate structure" and original claim 8 recites in part "coupling a hook to the frame for suspending the frame from a separate structure." For at least these reasons, Applicant submits that original claims 1 and 8 are patentably distinct over Sparks alone or in combination with Westfall. Also, for at least these same reasons, original dependent claims 2-7 and 9-14 are patentable.

New Claims

Applicant also respectfully submits that new claims 15-20 are patentable. In addition to being freestanding on a flat base 10 and pillar or stand 11, Sparks specifically teaches that his lamp has a shade with “a wire frame consisting of outwardly and downwardly curved wires 23 and circumferential wires 24, of increasing diameter toward the bottom, the lower end of the frame being below or laterally surrounding the bowl 16.” [Sparks at lines 80-88].

In contrast to Sparks, new claim 15 recites in part “a frame comprising a front portion and a back portion, the front portion comprising a plurality of curved members forming a skirt-supporting structure for supporting a skirt portion of a dress...[and the] back portion comprising a substantially planar portion forming a support structure for supporting the frame against a separate adjoining surface.” In further contrast to Sparks, new claim 16 recites in part “a fastener coupled to the frame for suspending the frame from the separate adjoining surface.” Also in contrast to Sparks, new claim 17 recites in part “the substantially planar portion abuts the separate structure when the frame is suspended from the hook.”

For at least these reasons, Applicant submits that new claims 15, 16, and 17 are patentably distinct over Sparks alone or in combination with Westfall, and that for at least these same reasons, new dependent claims 18-20 are patentable as well.

Conclusion

Applicant respectfully submits that the present claims are in condition for allowance. Furthermore, any remarks in support of patentability of one claim should not be imputed to any other claim, even if similar terminology is used. Any remarks referring to only a portion of a claim should not be understood to base patentability on that portion; rather, patentability must rest on each claim taken as a whole. Applicant respectfully traverses each of the Examiner's rejections and each of the Examiner's assertions regarding what the prior art shows or teaches, even if not expressly discussed herein. Although new claims have been added, no acquiescence or estoppel is or should be implied thereby; such amendments are made only to expedite prosecution of the present application and are without prejudice to the presentation or

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Reply to Office Action dated Sept. 26, 2006

assertion, in the future, of claims relating to the same or similar subject matter of the original claims.

The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

All of the claims remaining in the application are now clearly allowable. Favorable consideration and a Notice of Allowance are earnestly solicited.

Respectfully submitted,
SEED Intellectual Property Law Group PLLC

/Nathaniel Durrance/

Nathaniel Durrance
Registration No. 47,542

KSC:ned

701 Fifth Avenue, Suite 6300
Seattle, Washington 98104-7092
Phone: (206) 622-4900
Fax: (206) 682-6031

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